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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/669,594      | 09/26/2000  | Prasad Raje          | 004426.P001         | 5001             |

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Blakley Sokoloff Taylor & Zafman LLP  
12400 Wilshire Boulevard Seventh Floor  
Los Angeles, CA 90025

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| EXAMINER |
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BASHORE, WILLIAM L

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| ART UNIT | PAPER NUMBER |
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2176

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08/23/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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|------------------------------|---------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/669,594  | <b>Applicant(s)</b><br>RAJE, PRASAD |  |
|                              | <b>Examiner</b><br>William L. Bashore | <b>Art Unit</b><br>2176             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 126-167 is/are pending in the application.
- 4a) Of the above claim(s) 155-167 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 126-154 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: Response to Restriction filed 5/21/2007, to the original application filed 9/26/2000, with provisional filing date of 9/30/1999. IDS filed 5/4/2001.
2. Claims 126-167 pending. Claims 155-167 have been withdrawn by Applicant. Claims 126, 132, 137, 143 are independent claims.

#### ***Election/Restrictions***

3. Applicant's election of Group I claims in the reply filed on 5/21/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

#### ***Claim Rejections - 35 USC § 103***

4. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 126-127, 129-134, 136-138, 140-146, 148-154 are rejected under 35 U.S.C. 103(a) as being unpatentable over OmniForm User's Manual (hereinafter OmniForm), Caere Corporation, released March 22, 1999 (as evidenced by cited PR NewsWire article), pages 1-108, 173-199, in view of Hitchcock et al. (hereinafter Hitchcock), U.S. Patent No. 6,460,042 issued October 2002.**

**In regard to independent claim 126**, OmniForm teaches a form design application for designing, and editing an electronic form (OmniForm pages 25-43). OmniForm teaches opening a form, as well as e-mailing an electronic form using Outlook (OmniForm page 39-43). Since OmniForm can reopen any form in OmniForm format (see OmniForm page 15), Omniform can also receive an already created electronic form via email (typically including input fields). It is noted that an Omniform form is written in a form authoring language. (compare with “*A method comprising: receiving, through a network, a form authored using a form authoring language, the form containing one or more input fields;*”).

OmniForm teaches opening a form for redesigning, etc. (OmniForm page 15). In doing so, OmniForm reads and analyzes the underlying constructs of said form (which typically includes parsing the code) so as to create and/or re-create active input fields (compare with “*parsing the received form to identify the input fields contained in the received form;*”).

OmniForm teaches a graphical user interface dependent upon (associated with) the form’s input fields (OmniForm at least page 32), as well as the capability of opening a form file (e.g. a specific form submission) emailed from another user (a third party). OmniForm does not specifically teach allowing identification of actions to be associated with identified input fields. However, Hitchcock teaches a universal forms engine for form customization of on-line forms (Hitchcock Abstract). Hitchcock teaches an application description file (a series of directives and optional arguments) which is parsed to automatically build a corresponding HTML form (Hitchcock column 10 lines 42-65). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Hitchcock to OmniForm, providing OmniForm the benefit of extra emailed (or imported) directions to be applied to an already existing form. It is noted that Hitchcock deals with college submission forms, therefore it is reasonable that forms may need updating to account for differing input address parameters (if a student attended a college in a different country, etc.). (Compare with “*providing a graphical user interface to allow identification of actions to be associated with the identified input fields upon subsequent specific*”).

*submission of a specific instance the form by a third party, the provided graphical user interface being dependent on the identified input fields;”).*

OmniForm teaches generating program code to create active input fields with associated actions (see OmniForm Chapter 4, page 55). OmniForm is moot regarding “automatically” generating said code. However, Hitchcock teaches automatically creating (building) an HTML form based upon the above taught directives, and merging in user data (Hitchcock column 10 lines 42-65). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Hitchcock to OmniForm, providing OmniForm the benefit of automatically redesigning and updating forms in an expedient manner (compare with “*automatically generating a program code to carry out the actions associated with the identified input fields.*”

**In regard to dependent claim 127**, OmniForm teaches conversion of a form to HTML (OmniForm page 46-47).

**In regard to dependent claim 129**, OmniForm teaches generating program code to create active input fields with associated actions (see OmniForm Chapter 4, page 55).

**In regard to dependent claim 130**, claim 130 incorporates substantially similar subject matter as claimed in claim 126, and is rejected along the same rationale.

**In regard to dependent claim 131**, OmniForm teaches validation options for automatically validating input (OmniForm pages 76-77). If input does not validate, the user is notified accordingly.

**In regard to independent claim 132**, claim 132 reflects the system comprising computer readable instructions used for implementing the methods as claimed in claim 126, and is rejected along the same rationale.

**In regard to dependent claim 133**, OmniForm teaches a computer, typically incorporating a processor(s) (OmniForm page 8).

**In regard to dependent claims 134, 136**, claims 134, 136 reflect the system comprising computer readable instructions used for implementing the methods as claimed in claims 127, 131 respectively, and are rejected along the same rationale.

**In regard to claims 137-138, 140-142**, claims 137-138, 140-142 reflect the computer program product comprising computer readable instructions used for implementing the methods as claimed in claims 126-127, 129-131 respectively, and are rejected along the same rationale.

**In regard to independent claim 143**, claim 143 incorporates substantially similar subject matter as claimed in claim 126, and in further view of the following, is rejected along the same rationale.

OmniForm teaches receiving a form in design format (including the form and data) (OmniForm page 41). OmniForm does not specifically teach receiving an “instance” of said form. However, Hitchcock teaches directives used for creating a form and merging input data (Hitchcock column 10 lines 42-65). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Hitchcock to OmniForm, providing OmniForm the benefit of automatically redesigning and updating forms and input data in an expedient manner

**In regard to dependent claim 144**, OmniForm teaches validation options for automatically validating input (OmniForm pages 76-77). If input does not validate, the user is notified accordingly.

**In regard to dependent claim 145**, OmniForm teaches generating necessary quantities of associations as per input fields and Hitchcock's further directives (OmniForm at least page 32).

**In regard to dependent claim 146**, OmniForm teaches licensing (OmniForms page 48).

**In regard to dependent claims 148-149**, OmniForm teaches e-mailing a form, and using a routing slip (OmniForm page 40-43).

**In regard to dependent claims 150-151**, OmniForm teaches generating program code to create active input fields with associated actions (see OmniForm Chapter 4, page 55). OmniForm teaches receiving a form in a design phase, including both the form and data (OmniForm page 41).

**In regard to dependent claims 152-154**, OmniForm teaches management of database records (including data) in a database (typically comprising inclusion of records in various rows of a table (see OmniForm Chapter 7, page 173-199).

6. **Claims 128, 135, 139 are rejected under 35 U.S.C. 103(a) as being unpatentable over OmniForm, and Hitchcock as applied to claims 126, 132, and 137 above, and further in view of PR NewsWire article (hereinafter PR NewsWire), March 22, 1999, ProQuest Direct, pages 1-5.**

**In regard to dependent claim 128, 135, 139**, OmniForm does not specifically teach CGI. However, PR NewsWire teaches instructions for integrating CGI into forms (PR NewsWire page 4 item b). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply PR NewsWire to OmniForm, providing OmniForm the benefit of adding CGI scripting for collecting form data

7. **Claims 147 is rejected under 35 U.S.C. 103(a) as being unpatentable over OmniForm, and Hitchcock as applied to claim 143 above, and further in view of Davis et al. (hereinafter Davis) U.S. Patent No. 5,796,952 issued 8/1998.**

**In regard to dependent claim 147**, OmniForm does not specifically teach cookies. However, Davis teaches cookies (Davis column 11 lines 13-33, column 18 lines 33-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Davis to OmniForm, providing OmniForm the benefit of cookies for tracking users/data.

#### ***Response to Arguments***

8. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 2176

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*William F. Bashore*  
**WILLIAM BASHORE**  
**PRIMARY EXAMINER**

August 19, 2007